



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/247,406	02/10/1999	MICHAEL CAPLAN	HS105	7606

7590 11/15/2001

Brenda Herschbach Jarrell Choate Hall & Stewart
Exchange Place
53 State Street
Boston, MA 02109

EXAMINER

PONNALURI, PADMASHRI

ART UNIT	PAPER NUMBER
----------	--------------

1627

DATE MAILED: 11/15/2001

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/247,406

Applicant(s)
Caplan

Examiner
Padmeshri Ponnaluri

Art Unit
1627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 24, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 89-105 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 89-105 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Art Unit: 1627

DETAILED ACTION

NOTE the change of examiner in this application.

1. The request filed on 8/24/01 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/247,406 is acceptable and a CPA has been established. An action on the CPA follows.
2. The amendment C, filed on 8/24/01 has been fully considered and entered into the application.
3. All pending claims 1-3, 5-17, 19-23, 46-53 have been canceled, and new claims 89-105 have been added by the amendment C, filed on 8/24/01.
4. Claims 89-105 are currently pending in this application.
5. Upon further consideration of the new claims, the following restriction is required.

Election/Restriction

6. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 89-97, drawn to a method for identifying collection of mutant allergen proteins, classified in class 435, subclass 6.
 - II. Claims 98-103, drawn to a method for identifying mutant protein whose affinity for anti-therapeutic-polypeptide IgG is reduced, classified in class 435, subclass 6.

Art Unit: 1627

III. Claims 104-105, drawn to a method for identifying mutant proteins that have reduced T cell stimulatory activity, classified in class 435, subclass 6.

7. The inventions of groups I, II and III are distinct, each from the other because of the following reasons: Inventions of groups I, II and III are unrelated. The inventions of groups I, II and III are drawn to different methods which differ by the method steps and the reagents used and the end products. The group I method is drawn to identification of collection of mutant allergen proteins that have reduced IgE binding; group II methods are drawn to identifying mutant proteins whose affinity for anti-therapeutic-polypeptide IgG is reduced; group III methods are drawn to identifying mutant proteins that have reduced T cell stimulatory activity. Thus, the three methods differ from each other and restriction is proper. See (MPEP § 806.04, MPEP § 808.01).

8. Because these inventions are distinct for the reasons given above and the search required for each Group is different (the non patent literature search for each group would be different), and because of their recognized divergent subject matter restriction for examination purposes as indicated is proper.

9. This application contains claims directed to the following patentably distinct species of the claimed invention:

Art Unit: 1627

If group I is elected, applicants are requested to elect one single species of biological activity from claim 90.

The species claimed are distinct from each other because they are functionally different and do not require the other for ultimate use, the species election for examination purposes as indicated is proper.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 89-89, 91-97 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

Art Unit: 1627

examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

10. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

11. Applicant is required to reply to this restriction requirement within 30 days of mailing this action. See MPEP 809.2(a).

Please Note: In an effort to enhance communication with our customers and reduce processing time, a dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Jyothsna Venkat, Ph.D., Supervisory Patent Examiner at jyothsna.venkat@uspto.gov or 703-308-2439. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

Any inquiry concerning this communication should be directed to P. Ponnaluri whose telephone number is (703) 305-3884. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:30 pm.

Art Unit: 1627

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, can be reached at (703)308-2439. The fax number for this group is (703)305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)308-0196.

P. Ponnaluri
Patent Examiner
Technology center 1600
Art Unit 1627
26 October 2001


PADMASHRI PONNALURI
PRIMARY EXAMINER